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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/378,217   | 08/19/1999  | JEFFRY JOVAN PHILYAW | PHLY-24.707         | 8857             |
| 25883  | 7590        | 02/24/2005           | EXAMINER            |                  |
| HOWISON & ARNOTT, L.L.P.<br>P.O. BOX 741715<br>DALLAS, TX 75374-1715 |             |                      | NGUYEN, CHAU T      |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 2176                |                  |

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/378,217             | PHILYAW ET AL.      |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Chau Nguyen            | 2176                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/21/2005 has been entered. Claims 1-10 are presented for examination.

#### ***Terminal Disclaimer***

2. The terminal disclaimer filed on 05/24/2004 has been recorded.

#### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of Philyaw et al., U.S. Patent No. 6,643,692, and claims 1-4 of Philyaw et al., U.S. Patent No. 6,697,949. Although the conflicting claims are not identical, they are not patentably distinct from each other because the context of the claimed invention is the similar as the context of the cited claims of the U.S. Patent No. 6,643,692 and U.S. Patent No. 6,697,949.

5. All the claims 1-10 of the application have similar limitations to claims 1-10 of Philyaw et al., U.S. Patent No. 6,643,692 except the limitation "embedding a unique perceivable code, which does not containing routing information". Therefore, claims 1-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,643,692 and in view of Wolzien, Patent No. 5,761,606 for the limitation "embedding a unique perceivable code, which does not containing routing information".

The Philyaw et al. reference (6,643,692) discloses a method for controlling a computer with recorded information of a digital audio tape, comprising: embedding a unique code in the recorded audio information of the digital audio tape, extracting the unique code with an extractor during output of the recorded audio information to a user, transmitting the unique code to a remote location on the network in accordance with routing information stored at the user. Wolzien discloses an on line information provider address (unique perceivable code) embedded in a video or audio program is encoded in a vertical blanking interval, and the on line information provider address is detected and decoded from the electronic signal and used in establishing a direct signal communication link to the online information provider (thus, the address does not contain routing information) (Abstract and col. 3, line 25 – col. 4, line 48). Since Wolzien discloses address embedded in video or audio program, thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Wolzien and Philyaw et al. to include embedding a unique perceivable code, which does not contain routing information. Wolzien suggests that by providing automated and direct user access to online information providers through an address embedded in a video or audio program signal would obtain several benefits such as users could easily locate additional materials provided in text or still picture by the producers of the video program by accessing more information from the producers digitally through the online address.

6. Claims 1-10 of the application have similar limitations to claims 1-4 of Philyaw et al., U.S. Patent No. 6,697,949 except the limitation "when playing back the recorded information, the unique perceivable code will be output within the video/audio bandwidth of the compact disk". Therefore, claims 1-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,697,949 and in view of claims 1-10 of US. Patent No. 6,643,692 for the limitation "when playing back the recorded information, the unique perceivable code will be output within the video/audio bandwidth of the compact disk."

The Philyaw et al. reference (6,697,949) discloses a method for allowing a consumer to access an advertiser's location over a global communication network from a consumer's computer, comprising the steps of: a broadcast program having a unique signal embedded therein contains no routing information and is associated with a particular advertiser and a predetermined location on the network and wherein the unique signal has encoded therein a unique code that correlates with the location of this predetermined location on the network; receiving the unique signal at a consumer's location; decoding the unique signal to extract therefrom the unique code; and accessing a database according to the unique code for determining routing information to the predetermined location on the network from a consumer's computer on the network at the consumer's location. The Philyaw et al. reference (6,643,692) discloses the similar information as discussed in reference 6,697,949 with additional limitation of "when playing back the recorded information, the unique perceivable code will be output within the video/audio bandwidth of the compact disk". It would have been obvious to one of

Art Unit: 2176

ordinary skill in the art at the time the invention was made to interpret that the unique perceivable code will be output during the playback so an extractor would be able to extract the unique code during the output of the recorded information to a user.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 4-6, and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bendinelli et al., U.S. Patent No. 6,061,719 in view of Ullman et al., U.S. Patent No. 6,018,768, and further in view of Wolzien, U.S. Patent No. 5,761,606 and further in view of Berry et al., US Patent No. 6,195,693.

9. As to claims 1 and 6, Bendinelli et al. (Bendinelli) discloses the invention as claimed.

the unique code in close association with vendor information (col. 2, line 51 – col. 3, line 12 and col. 3. line 57 – col. 4, line 13: teaches a URL or other type of network information identifier which identifies a web site (vendor information));

extracting the unique code with an extractor during output of the recorded information to a user at a user location disposed on a network (col. 3, line 13 – col. 4, line 13 and col. 5, line 57 – col. 6, line 11: teaches a decoder extracts and embedded URL or other type of network information identifier from a closed caption stream (output information) and delivers it to a computer via a suitable connection (network));

in response to extracting the unique code, transmitting the unique code to a remote location on the network in accordance with routing information accessible at the user location, wherein the vendor product information is returned to the user location for processing (Abstract, col. 2, line 51 – col. 3, line 35 and col. 5, line 57 – col. 6, line 11: teaches from extracting the URL or other network information identifier (unique code) identifying a web site at a server (remote location) and wherein a web page (vendor information) is delivered to the computer for display).

However, Bendinelli does not explicitly disclose the unique code in recorded information of the compact disk and which unique code is embedded within the video/audio bandwidth of the recorded information, and the unique code will be output during normal playback of the compact disk and within the video/audio bandwidth thereof. Ullman et al. (Ullman) discloses on col. 5, lines 28-30, col. 9, lines 4-35, and col. 10, lines 4-25: teaches operating a DVD player at a user site to read a video program with embedded URLs (unique code) which is stored or recorded in a digital video disk and video program is displayed on the user site. Ullman also discloses the URLs (unique codes) identifying the Web site and time stamps are sent automatically to the desktop of each student either during playback of a pre-recorded program or during a live event



Art Unit: 2176

(col.10, lines 33-49). Since Ullman discloses a system for integrating video programming with the information resources of the Internet, which is similar to synchronized presentation of television programming and web content of Bendinelli, It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a digital video disk (DVD) storing video program with embedded URLs and DVD player to retrieve video program to display on user site and the URLs (unique codes) identifying the Web site and time stamps are sent automatically to the desktop of each student either during playback of a pre-recorded program or during a live event as taught by Ullman, and extract a unique code to identify the location of a server corresponding that unique code, as taught by Bendinelli, in a digital computing environment. The motivation to do so would have been to provide a user friendly environment by giving customers additional information automatically through the Internet.

However, Bendinelli and Ullman do not explicitly disclose embedding a unique perceivable code, which does not contain routing information. In the same field of endeavor, Wolzien disclose an on line information provider address (unique perceivable code) embedded in a video or audio program is encoded in a vertical blanking interval, and the on line information provider address is detected and decoded from the electronic signal and used in establishing a direct signal communication link to the online information provider (thus, the address does not contain routing information) (Abstract and col. 3, line 25 – col. 4, line 48). Since Wolzien discloses address embedded in video or audio program, which is similar to a system for integrating video programming with the

information resources of the Internet of Ullman and synchronized presentation of television programming and web content of Bendinelli, thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Wolzien and Bendinelli and Ullman to include embedding a unique perceivable code, which does not contain routing information. Wolzien suggests that by providing automated and direct user access to online information providers through an address embedded in a video or audio program signal would obtain several benefits such as users could easily locate additional materials provided in text or still picture by the producers of the video program by accessing more information from the producers digitally through the online address.

However, Bendinelli, Ullman and Wolzien do not explicitly disclose which routing information defines the location of the remote location on the network. Berry et al. (Berry) discloses a method for automatically retrieving and presenting data associated with audio recording having unique identifying indicia therein, and in response to playing an audio recording in a multimedia computer system, a unique identifying indicia associated with the audio recording is identified, a listing of codes (routing information) within the multimedia computer system is automatically searched to find a code corresponding to the unique identifying indicia, and in response to finding the code corresponding to the unique identifying indicia, multimedia data is retrieved from local remote network site (Abstract, Fig. 7 and col. 9, line 37 – col. 10, line 52). Since Berry discloses a method for network delivery of content associated with physical audio media, which is similar to the methods of Bendinelli, Ullman and Wolzien, thus it would have

Art Unit: 2176

been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Berry and Bendinelli, Ullman and Wolzien to include routing information which defines the location of the remote location on the network in order to provide a unique and effective solution which combines conventional audio CDs with on-demand multimedia distribution over the Internet.

10. As to claims 4 and 9, Bendinelli, Ullman, Wolzien and Berry (Bendinelli-Ullman-Wolzien-Berry) disclose the network is a global communication network that provides a universal resource locator (URL) for each location on the network and the routing information is comprised of the URL for the location (Bendinelli, col. 2, line 51 – col. 3, line 12).

11. As to claims 5 and 10, Bendinelli-Ullman-Wolzien-Berry disclose the unique perceivable code is an audible tone (Bendinelli, col. 2, line 51 – col. 4, line 13: teaches network information identifier can be embedded in any other type of signal; Wolzien: Abstract, and col. 3, line 25 – col. 4, line 48: links video and audio program content with online video or audio information signal content).

12. Claims 2-3 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bendinelli-Ullman-Wolzien-Berry as applied to claims 1, 4-6 and 9-10 above, and further in view of Hitzelberger, U.S. Patent No. 6,061,368.

Art Unit: 2176

13. As to claims 2 and 7, Bendinelli-Ullman-Wolzien-Berry disclose the invention substantially as claimed as described supra. However, Bendinelli-Ullman-Wolzien do not explicitly teach an intermediate location on the network for comparing the received unique code with the stored vendor routing information in the database. Hitzelberger discloses on col. 4, lines 9-56: a routing engine (intermediate location) for matching source identifiers with the destination identifiers from a cache (stored vendor routing information) in the routing engine. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a routing engine (intermediate location), as taught by Hitzelberger, to identify a web site at server using a code, as taught by Bendinelli-Ullman-Wolzien, in a network environment. The motivation to do so would have been to provide a routing engine to match the source identifier with the destination identifiers stored in the cache to be able to identify the web page (vendor information) at a server for interconnection increasing the reliability in establishing connection between source and destination.

14. As to claims 3 and 8, Bendinelli-Ullman-Wolzien-Berry and Hitzelberger (Bendinelli-Ullman—Wolzien-Berry-Hitzelberger) disclose the user location further includes user ID information that uniquely identifies the user at the user location (Hitzelberger, col. 4, line 9-56: teaches a source identifier), and

wherein the database at the intermediate node includes user profiles information which is associated therein with the user ID information of the user location (Ullman, col. 3, line 44 – col. 4, line 4), and

wherein the step of transmitting the unique perceivable code over the network to the intermediate location also includes transmitting the user ID information to the intermediate location, and the step of matching further comprises matching the received user ID information of the user location with stored profile information associated with the received user ID information (Wolzien, Abstract, and col. 3, line 25 – col. 4, line 48; Hitzelberger, col. 4, line 9-56: teaches routing engine (intermediate node) which includes identifier, and a matching function for comparing source identifier with a destination identifiers stored in cache to be encoded in a packet that is transmitted to the destination), and

wherein the step of transmitting the matching vendor routing information back to the user location further includes appending to the vendor routing information the stored profile information, and wherein the stored profile information is transmitted to the remote vendor information location via the user location (Hitzelberger, col. 4, line 9-56).

### ***Response to Arguments***

15. In the remarks, Applicants argued in substance that

(A) In the Bendinelli reference, the embedded URL cannot be considered to be a unique code that does not contain routing information.” (see page 8 of remarks)

As to point (A), in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In this case, Bendinelli et al. (Bendinelli) discloses the invention as claimed.

the unique code in close association with vendor information (col. 2, line 51 – col. 3, line 12 and col. 3. line 57 – col. 4, line 13: teaches a URL (unique code) or other type of network information identifier which identifies a web site (vendor information) and col. 3, line 13 – col. 4, line 13 and col. 5, line 57 – col. 6, line 11: teaches a decoder extracts and embedded URL or other type of network information identifier from a closed caption stream (output information) and delivers it to a computer via a suitable connection (network));

However, Bendinelli does not explicitly disclose the unique code in recorded information of the compact disk and which unique code is embedded within the video/audio bandwidth of the recorded information, and the unique code will be output during normal playback of the compact disk and within the video/audio bandwidth thereof. Ullman et al. (Ullman) discloses on col. 5, lines 28-30, col. 9, lines 4-35, and col. 10, lines 4-25: teaches operating a DVD player at a user site to read a video program with embedded URLs (unique code) which is stored or recorded in a digital video disk and video program is displayed on the user site. Ullman also discloses the URLs (unique codes) identifying the Web site and time stamps are sent automatically to the desktop of

Art Unit: 2176

each student either during playback of a pre-recorded program or during a live event (col.10, lines 33-49). Since Ullman discloses a system for integrating video programming with the information resources of the Internet, which is similar to synchronized presentation of television programming and web content of Bendinelli, It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a digital video disk (DVD) storing video program with embedded URLs and DVD player to retrieve video program to display on user site and the URLs (unique codes) identifying the Web site and time stamps are sent automatically to the desktop of each student either during playback of a pre-recorded program or during a live event as taught by Ullman, and extract a unique code to identify the location of a server corresponding that unique code, as taught by Bendinelli, in a digital computing environment. The motivation to do so would have been to provide a user friendly environment by giving customers additional information automatically through the Internet.

However, Bendinelli and Ullman do not explicitly disclose embedding a unique perceivable code, which does not contain routing information. In the same field of endeavor, Wolzien disclose an on line information provider address (unique perceivable code) embedded in a video or audio program is encoded in a vertical blanking interval, and the on line information provider address is detected and decoded from the electronic signal and used in establishing a direct signal communication link to the online information provider (thus, the address does not contain routing information) (Abstract and col. 3, line 25 – col. 4, line 48). Since Wolzien discloses address embedded in video

Art Unit: 2176

or audio program, which is similar to a system for integrating video programming with the information resources of the Internet of Ullman and synchronized presentation of television programming and web content of Bendinelli, thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Wolzien and Bendinelli and Ullman to include embedding a unique perceivable code, which does not contain routing information. Wolzien suggests that by providing automated and direct user access to online information providers through an address embedded in a video or audio program signal would obtain several benefits such as users could easily locate additional materials provided in text or still picture by the producers of the video program by accessing more information from the producers digitally through the online address.

16. Applicant's arguments and amendments filed on 01/21/2005 have been fully considered but they are not deemed fully persuasive. Also, Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection. Please see the rejection and response to arguments above.



Art Unit: 2176

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau Nguyen whose telephone number is (571) 272-4092. The Examiner can normally be reached on Monday-Friday from 8:00 am to 5:00 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Joseph Feild, can be reached at (571) 272-4090.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chau Nguyen  
Patent Examiner  
Art Unit 2176

  
**JOSEPH FEILD**  
**SUPERVISORY PATENT EXAMINER**